

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Stephens)
For: Location-Based Mobile Service)
Provision)
Serial No.: 10/539,849)
Filing Date: December 5, 2003)
371(c) Date: June 20, 2005)
Examiner: Karikari, K.)
Art Unit: 2617)

Pre-Appeal Brief Request for Review

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby request review of the final rejection in the above-identified application. No amendments are being filed with this request. The present request is being filed in conjunction with a notice of appeal. The review is being requested for the reasons stated below, which frames the issue to be considered as part of the pre-appeal review process.

The Examiner continues to reject claims 32-55. More specifically, the Examiner has rejected claims 32-55 under 35 USC §112, first paragraph as failing to comply with the written description requirement (independent claims 32 and 52), or presumably as being dependent upon a claim that allegedly fails to comply with the written description requirement (dependent claims 33-51 and 53-55). The Examiner has further rejected claims 32-47 and 49-55 under 35 USC §102(e) as being anticipated by Haddad et al., US Published Patent Application No. 2003/0137435; and still further has rejected claims 48 under 35 USC §103(a) as being unpatentable over Haddad et al., '435, in view of Kinnunen et al., US Published Patent Application No. 2001/0018349.

However contrary to the Examiner's assertions, the specification satisfies the written description requirement, so as to reasonably convey to one skilled in the art that the inventor, at the time the application was filed, had possession of the claimed invention. Furthermore, contrary to the Examiner's assertions, the relied upon references fail to make known or obvious each and every feature of the claims, and therefore cannot be said to make known or obvious any of the respective claims.

In alleging that the specification fails to comply with the written description requirement, the Examiner has appeared to focus on the amended claim feature "traveling to a previously (un?)disclosed location". The Examiner alleges that the specification fails to provide support for such a feature, as well as characterizes the feature as constituting new matter. However contrary to the Examiner's assertions, support for the feature "traveling to a previously undisclosed location" is provided, where the mobile service provider is characterized as "roaming" (see page 12, lines 17-24) and in the manner in which at least one example of a notification of an availability of a service at a respective location can be identified, where a cell broadcast can be made to a particular cell area when the service provider is in, or has indicated a subsequent visit to a cell area (see page 12, lines 30-34), and/or where the previously identified location (i.e. postcode) of the users having an interest in a particular service corresponds to the location (which in the particular embodiment is continuously updated) of the service provider as they move into, or approach a particular location (i.e. postcode) (see page 13, lines 1-10).

Roaming is defined by the American Heritage Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. 27 Aug. 2007. <Dictionary.com <http://dictionary.reference.com/browse/roaming>> as moving about without purpose or plan; (i.e. wander).

The Applicant's use of the phrase "roaming" in the specification as originally filed, effectively embodies the particular claim language in question, especially when considered in the full context of the entire specification.

While the Examiner may be seeking a showing where the exact language can be found in the specification as originally filed, such a requirement is misplaced, as there is no such requirement.

As articulated by the Federal Circuit, the test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably

conveys to the artisan that the inventor had possession at the time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). It is well settled, that a determination as to whether the originally filed disclosure of the application reasonably conveys to the artisan an indication that the inventor had possession of the claimed subject matter, does not require that the claimed subject matter be described identically. Precisely how close the original description must come in order to comply with the description requirement must be determined on a case-by-case basis. In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984) (emphasis added).

In the present instance, while the claimed subject matter is not described identically, there is no such requirement. Further, in view of at least the portions of the application noted above, one skilled in the art would understand that the inventors had possession of the later claimed subject matter, at the time the application was originally filed. Consequently, the corresponding rejection relative to independent claims 32 and 52, and the claims which depend therefrom, should be withdrawn.

Relative to the alleged anticipation of at least independent claims 32 and 52, which the Examiner alleges are anticipated by Haddad et al., '435, contrary to the Examiner's assertion Haddad et al., '435, fails to make known each and every feature of claims 32 and 52, and indirectly any of the claims, which depend therefrom. More specifically, as previously identified by the applicant, Haddad et al., '435, minimally fails to make known or obvious the feature of "the mobile service provider traveling to a previously undisclosed location where a service is to be performed". While the Examiner has attempted to identify a couple of passages from the cited reference, which allegedly make known or obvious such a feature, when one reviews the specific passages noted, the passages fail to teach or suggest the features they are alleged to make known. Taking each of the passages individually, the fact that each vehicle may have a route comprising a plurality of different stops [0035] is irrelevant, the path for each vehicle still defines a route, which generally defines "a customary or regular line of passage or travel", and/or "a specific itinerary, round, or number of stops regularly visited by a person in the performance of his or her work" – see Dictionary.com Unabridged (v 1.1). Random House, Inc. 27 Aug. 2007. <Dictionary.com <http://dictionary.reference.com/browse/route>>. In other words, there is no suggestion that the locations are previously undisclosed, and in fact the alternative

use of the term route, which generally corresponds to customary or regular line of passage or travel – speaks to the contrary.

The Examiner's allegation that the specified location may not be predetermined referencing paragraph [0019], similarly cannot be supported, where the particular passage indicates that the specified location may be a predetermined, fixed, stopping point, or vehicle stop, for the vehicle, or alternatively the specified location may not be so predetermined, but could be a more variable predetermined specified location. In each instance the location is still identified as being predetermined. Furthermore, viewed in its full context, the paragraph refers to the type of stop (i.e. bus stop, train station, airport, taxi rank vs. any house or location to which a taxi is to arrive), and not whether the location was previously undisclosed. In fact, the very next paragraph clearly characterizes the corresponding event as an “expected” event [0020], not unlike the expected occurrence of an event [0009].

The Examiner's further characterization, that a particular bus can be added or diverted to a particular route [0024], does not exclude the fact that the different vehicles and their corresponding location past, present and future is associated with a particular route, and the corresponding locations along a particular route, upon association with that route. Lastly, paragraph [0047], while it suggests that a non-route fixed transport is possible, still characterizes the position and the particular pick up point of the vehicle as being known. While the Examiner has cited several different sections, none of the cited sections contradict the characterization of the teachings from the cited reference as relating to an expected event and/or occurrence of an event [0009] and [0019]. As a result, contrary to the Examiner's assertions, the reference fails to teach or suggest a relationship relative to “a mobile service provider traveling to a previously undisclosed location where a service is to be performed”. Correspondingly, contrary to the Examiner's assertions, the reference fails to make known or obvious each and every feature of the independent claims, and indirectly each of the claims which depend therefrom. Kimmunen et al., '349, fails to account for the above noted deficiencies of Haddad et al., '435.

In view of the above remarks, the applicants would respectfully request that the Examiner's final rejection of the claims be withdrawn.

Respectfully submitted,

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